

# BEST AVAILABLE COP

Atty. Dkt. No. 035451-0120 (3600.Palm)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

Hanson et al.

Title:

EXPANDABLE

MINIATURE

ACCESSORY CARD FOR HANDHELD COMPUTER

Appl. No.:

09/821,522

Filing Date:

3/29/2001

Examiner:

Trisha U. Vu

Art Unit:

2112

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the
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1450, Alexandrin, VA 22313-1450.

EV 459171258 US 01/21/05

(Express Meil Label Number) (Dage of Deposit)

Robertas A. Cooper

(Printed Name)

(Signature)

DECLARATION UNDER 37 C.F.R. § 1.131

Commissioner for Patents PO Box 1450 Alexandria, Virginia 22313-1450

Sir:

We, Yoon Kean Wong and William R. Hanson, state and declare that:

- Each of us conceived the subject matter recited in at least one of Claims 1-69 currently pending in U.S. Patent Application No. 09/821,522 titled "Expandable Miniature Accessory Card for Handheld Computer" (hereinafter referred to as "the '522 application").
- We understand that in an Office Action dated November 02, 2004, Claims 1-69 were rejected as being unpatentable.
- 3. We understand that the rejection of Claims 47-69 was based in part on the use of U.S. Patent Application Publication No. 2001/0042149 to Ito et al., entitled "Peripheral Device for Information Processing" (hereinafter "Ito et al.").
- 4. We understand based on the information provided on the front page of <u>Ito et al.</u> that <u>Ito et al.</u> has a filing date of December 28, 2000.

- 5. At least by December 11, 2000, we conceived the ideas set forth in Claims 1-69 of the '522 application. Such conception is evidenced by the following attached document:
  - A copy of an Invention Disclosure Form that indicates a conception date of December 11, 2000 in Section 3, on page 2, in Santa Clara, CA (Attached as Exhibit A).
- 6. Based on the document provided herewith and our best recollection, the conception of the ideas set forth in Claims 1-69 of the '522 application took place at least by December 11, 2000, which is before the December 28, 2000 filing date of <u>Ito et al.</u>
- 7. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent application or any patent issuing therefrom.

Date: 1/14/05	By: Kean Wong
Date:	By:William R. Hanson



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**EXPANDABLE** 

**MINIATURE** 

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Roberta A. Cooper

(Printed Name)

u u

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Date:	Ву:
	Yoon Kean Wong
Date: // /2 '05	By:
	William R. Hanson

Docket Number: 3600.Palm Office Use Only

# Palm, Inc. Invention Disclosure Form

5470 Great America Parkway, Santa Clara, CA. 95052.

#### Instructions:

Date Stamp:

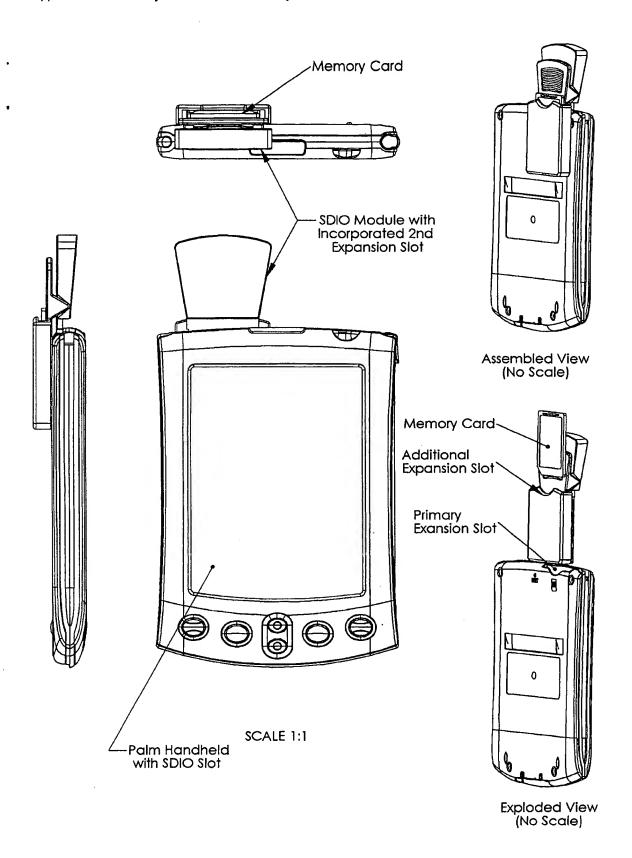
- Any questions regarding this form should be referred to Henry Ohab at (408) 326-5501, Fax: (408) 326-5009, or E-mail <a href="https://example.com">Henry Ohab@Palm.com</a>
- Return Completed Form To: Henry Ohab

San			
1: Title of the in	ventjorg : Write a shor descr	iolive title: avoiding coine	dilerms and project names. 4-118
	essory (SDIO) Card for a Hand	held Computer	
2. Inventors	include the names of all per include the names of all per	sons who made a contribution of this	ition to the conception of the navention.
Full Name:	William Robert Hanson	M.S.	16124
Home Address:	605 Pettis Ave., Mountain V	iew, CA 94041	
Home Phone:	650.962.1817	Work Phone:	408.326.0196
Employee No.	25202		
Supervisor:	Frank Canova	Location:	Bidg. 16 (Santa Clara)
Citizenship:	USA	<del></del> :	
Full Name:	Yoon Kean Wong	M.S.	10302
Home Address:	200 Linfield Drive, #1 Menl	o Park, CA 94025	
Home Phone:	650.321.6382	Work Phone:	408.326.9901
Employee No.	23210	<del> </del>	
Supervisor:	Ken Comstock	Location:	Bldg. 10 (Santa Clara)
Citizenship:	New Zealand	:	
Full Name:		M.S.	
Home Address:			
Home Phone:		Work Phone:	
Employee No.			
Supervisor:		Location:	
Citizenship:		<del></del> :	
Full Name:		M.S.	
Home Address:			
Home Phone:		Work Phone:	
Employee No.			
Supervisor:		Location:	
Citizenship:			
inis inventionio sc	euraline in a la companie de la comp	nife your amploying it	aureeneneviin Reim incelo ees
accordance with se	ild agreement you have agreed	o assignant hereby (	ભારતાના કાર્યો છે. જે તેમ માના કાર્યો છે છે. જે
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3 Conception of the invention	
Date of conception: December	11, 2000 Location of conception Palm Source 2000
4 Related As This Strategy	
Is this invention an improvement of an exi	isting COMPANY product? No 🛛 Yes 🗌
If "Yes," identify the existing prod	uct: N/A
and identify the improvement	
What was the problem to be solved?	A means to add additional media or memory to SD card equiped handheld device once the slot has been occupied by a SDIO module. This is accomplished through the addition of a second SD or MMC slot connector.
How had others attempted to solve it before you?	Yes, San Disk and Socket Communications have proposed a two part SDIO card. One portion is the I/O function and the second portion being the media or memory. This does not provide an additional socket.
What were the problems or disadvantages with prior solutions?	Mechanically the San Disk / Socket device is inferior. It also does not provide a means of adding media or memory using standard SD or Multimedia cards.
What are the closest known prior art technology or products?	Innogear ( http://www.innogear.com/ ) has a Handspring  Springboard Module MP3 player that accepts Multimedia card media.
5. Reference Materials List any printed publications, patents, patent applications or any other materials you are aware of which provides background material and/or prior art for your invention.  What other companies or inventors might	Innogear ( http://www.innogear.com/ )
have prior art?	

#### 6: Drawings of the Invention

Please submit clear drawings which illustrate the invention either by electronically inserting them below or by using supplemental sheets if you cannot electronically insert them.



## Palm, Inc. Confidential

Docket Number: 3600.Palm Office Use Only

to understand how you solved the problem. Explabove.  SDIO modules such as MP3 players, GPS recomedia. (i.e. MP3 formatted songs etc.) Having cost of the module as well as requires a mean content is available on SDIO module. Having the solution of the so	f the invention in just enough detail to enable someone technical lain how the invention solves the problem identified in Section 4 eivers, and digital cameras require the transfer of digital g this memory available on the SDIO device increases the as to download alternative content. Only a finite amount of removable media allows the user to pick and choose the expands on the "traditional" SDIO module by providing a MMC connector.
8. Strategic/Factical Value of the Invention Very briefly, explain how this invention will have shelp Palm, Inc. and/or how could such a patent a future?	strategic value to the company. That is, how could such a patent dversely affect our competitors, both in the present and in the
protect our 3 <sup>rd</sup> party developers from being pr a solution to the single SD slot problem that e	modules at this time, the primary purpose of this patent is to revented from using this format. However, this does provide exists on competitive handheld devices as well as ours. This further evangelize the use of Secure Digital Media.
9. Joint Development or Development Contra	oct ·
Was this invention jointly developed with inventor	rs from another company? No 🛛 Yes 🗌
If "Yes," please identify the company and	d/or non-Palm inventors:
10 Releases	
Expected/actual date of first public release or showing of invention or product incorporating or using the invention.	No date set.
11 Publication of the invention.  Publication of a description of the invention may affect publication has occurred.	t COMPANY's right to patent the invention. Submit this form even if
Has a description been published or is it schedule	ed to be published? No ⊠ Yes □
If "Yes," when and to whom?	
12: Attorney	

If there is a particular patent attorney with whom you would like to work on this disclosure,

suggest his/her name.

None.

This is a SUPPLEMENTAL INVENTOR SHEET which is to be used if there are more than 4 inventors for the invention set out in the Invention Docket specified above.

Full Name: M.S.	
Home Address:	
Home Phone: Work Phone:	
Employee No.	
Supervisor: Location:	
Citizenship: :	
Full Name: M.S.	
Home Address:	
Home Phone: Work Phone:	
Employee No.	
Supervisor: Location:	
Citizenship: :	
Full Name: M.S.	
Home Address:	
Home Phone: Work Phone:	
Employee No.	
Supervisor: Location:	
Citizenship: :	
Full Name: M.S.	
Home Address:	
Home Phone: Work Phone:	
Employee No.	
Supervisor: Location:	
Citizenship: :	
Full Name: M.S.	
Home Address:	
Home Phone: Work Phone:	
Employee No.	
Supervisor: Location:	
Citizenship: :	

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